

THIS DISPOSITION IS NOT
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Paper No. 8
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Burlingame Industries, Inc.
v.
Allmet Building Products, Inc.

Opposition No. 117,553
to application Serial No. 75/728,376
filed on June 14, 1999

Edward R. Schwartz of Christie, Parker & Hale, LLP for
Burlingame Industries, Inc.

Darrell L. Olson of Knobbe, Martens, Olson & Bear, LLP
for Allmet Building Products, Inc.

Before Hohein, Bottorff and Rogers, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal
Register of the mark CAPISTRANO TILE (in typed form; TILE
disclaimed) for "metal roofing panels." The application

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was filed on June 14, 1999 on the basis of use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and May 25, 1999 is alleged in the application as the date of first use of the mark anywhere and first use of the mark in commerce.

Opposer filed a timely notice of opposition to registration of applicant's mark, alleging as grounds therefor that applicant's mark, as applied to applicant's goods, so resembles opposer's mark CAPISTRANO, used by opposer since 1989 as a mark for "roofing tiles," as to be likely to cause confusion, to cause mistake, or to deceive. See Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed an answer denying the allegations of the notice of opposition which are essential to opposer's claim.

The evidence of record consists of the January 11, 2001 testimony deposition of Roger D. Thompson, opposer's vice-president and president of opposer's Eagle Roofing Division, and the exhibits thereto. Applicant was not represented at the deposition and did not cross-examine the witness. Applicant presented no evidence during applicant's testimony period.

Opposer filed a brief on the case, but applicant did not. No oral hearing was requested. We sustain the opposition.

The undisputed evidence of record establishes that opposer has used the mark CAPISTRANO in connection with roofing tiles since 1989. (Thompson depo. at 10). Thus, opposer's use of its mark pre-dates applicant's application filing date and claimed date of first use by ten years. In view thereof, we find that opposer has standing to oppose registration of applicant's mark, as well as priority for purposes of its Section 2(d) ground of opposition.¹

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on

¹ The evidence of record also shows that opposer is the owner of application Serial No. 75/751,610, by which opposer seeks registration on the Principal Register of the mark CAPISTRANO for "roofing tiles." Applicant's prior-filed application (the application involved in this proceeding) has been cited as a potential Section 2(d) bar to registration of opposer's mark, and opposer's application has been suspended pending registration or abandonment of applicant's application. These facts, as well, establish opposer's standing. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find that applicant's mark CAPISTRANO TILE is highly similar to opposer's previously-used mark CAPISTRANO in terms of appearance, sound, and meaning. Indeed, but for applicant's addition to its mark of the disclaimed descriptive or generic word TILE, the marks are identical. We find that the marks create the same overall commercial impression, notwithstanding the presence of the word TILE in applicant's mark. This similarity of the marks weighs heavily in favor of a finding of likelihood of confusion in this case.

We also find that applicant's goods, i.e., "metal roofing panels," are closely related, if not legally identical, to opposer's "roofing tiles." Mr. Thompson's undisputed testimony establishes that applicant's and opposer's goods are competitive products which are marketed and sold in the same trade channels and to the same classes of purchasers. (Thompson depo. at 22-23.)

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In summary, we find that applicant's mark is highly similar to opposer's previously-used mark, and that applicant's goods and opposer's goods, and the trade channels and classes of purchasers for such goods, likewise are highly similar if not identical. Having considered all of the *du Pont* likelihood of confusion factors for which there is evidence of record, we conclude that a likelihood of confusion exists. In view thereof, and because opposer also has established its priority and standing to oppose, we find that opposer is entitled to prevail in this case.

Decision: The opposition is sustained.